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10/622,364

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Troy L. Bartlett

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EXAMINER

LU, CHARLES EDWARD

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/622,364	Applicant(s) BARTLETT ET AL.	
	Examiner Charles E. Lu	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/23/05; 3/21/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-40 have been submitted for examination.
2. Claims 1-40 have been rejected.

Drawings

3. The drawings are objected to because of the following informalities:

Reference numerals 360 and 400 of fig. 2B do not appear to be present in the drawing. The reference numerals are described in page 25, lines 20-21 of the specification.

As to fig. 1, reference numeral #14E does not appear to have been mentioned in the specification.

As to fig. 2A, reference numeral #48 does not appear to have been mentioned in the specification.

As to fig. 2B, reference numerals 61, 68, 65, 64, 66, 63, and 67 appear to have not been mentioned in the specification.

As to fig. 2B and 2C, the numeral #72 references different components.

The drawings should be carefully checked for all informalities, including ensuring that all reference numerals are present and described in the specification, and ensuring that the same numeral does not reference different components.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to because of the following informalities:

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. A few informalities are listed below. The list should not be taken as exhaustive.

As to page 2, last line, "conceptualized a computer device" should be changed to conceptualized as a computer device for grammatical correctness.

As to page 17, line 21, mention should be made to reference numeral #14E of the drawing.

As to page 18, line 19, the acronym "WAP" should be resolved on the first use. Acronyms throughout the specification should be resolved on their first use.

As to page 25, lines 20-21, the reference numerals 360 and 400 do not appear to be present in the drawings.

As to page 26, line 18, the reference numeral 72 appears to also represent an operating system on fig. 2B #72.

The specification does not appear to mention reference numeral #48 of fig. 2A.

The specification does not appear to mention reference numerals 61, 68, 65, 64, 66, 63, and 67 of fig. 2B.

The specification should be carefully checked to ensure that all reference numerals of the drawings are described correctly and consistently.

The title of the invention is neither precise nor descriptive. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the prior art. It is recommended that the title should reflect the gist of or the improvement of the present invention.

Appropriate corrections are required.

Claim Objections

5. Claims 1-40 are objected to because of the following informalities:

As to claim 1, line 6, "set of setting" should be changed to set of settings for proper antecedent basis and grammatical correctness. A non-exhaustive list of other claims containing this deficiency includes claims 4, 5, 7, 8, and 10.

As to claim 6, line 2, "multiple sets further" should be changed to multiple sets of settings further for proper antecedent basis.

Dependent claims are objected to at least because of their dependency on objected parent claims and the deficiency concerning a "set of setting."

Appropriate corrections are required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 11-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 11, while Applicants have used the term "device," each of the "module" elements of the device are reasonably interpreted as software, such that the elements of the "device" do not support it being hardware. Therefore, the claim is software per se, and non-statutory.

As to claim 21, the specification (pp. 24-25) is evidence Applicant intends for it to cover non-functional descriptive material (e.g., paper with the program printed on it), and propagation media (e.g., signals), not currently believed to fall within a statutory category of invention. .

As to claim 31, while Applicants have used the term "device," each of the "logic" elements of the device are reasonably interpreted as software, such that the elements of the "device" do not support it being hardware. Therefore, the claim is software per se, and non-statutory.

Dependent claims inherit the deficiencies from rejected independent claims 11, 21, and 31, and do not cure the deficiencies, and are therefore rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 5-6, 15-16, 25, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 5, 15, 25, and 35, the subject matter of determining when there is a conflict was not described in the specification. No references to determining when there is a conflict were found in the specification.

Claims 6 and 16 are rejected under 35 U.S.C. 112, first paragraph, based on their dependency on rejected claims 5 and 15.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 3, 10, 18, and 21-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 3, line 6, it is unclear to which set of settings "the set of settings" refers.

As to independent claims 21 and 31, it is unclear how the claimed medium or system can be "for a logic," or have "means for logic," respectively, and how such would enable the functionality of the logic to be realized. The logic in claims 21-30 and 31-40 is reasonably interpreted to be program code.

As to claims 10, 18, 28, and 38, the claims do not comply with the requirements of 35 U.S.C. 112, second paragraph because the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product (i.e. Push Sync or Ready Sync settings). *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a

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claim indefinite, but would also constitute an improper use of the trademark or trade name.

Dependent claims of rejected independent claims are also rejected under 35 U.S.C. 112, second paragraph.

The broadest reasonable interpretation of the above terms in light of the specification has been given to the claims. Art rejection of the above claims is applied as best understood in light of the rejection under 35 U.S.C. 112, second paragraph, discussed above.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 2, 7-12, 15, 17-22, 25-32, 35, and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Zanchi et al (U.S. Patent 5,633,484).

As to claim 1, Zanchi teaches the claimed subject matter including:

Determining an operation on a computer device (col. 9, ll. 25-40);

Determining and acquiring a set of settings to perform the operation on the computer device (col. 7, l. 60 – col. 8, l. 15);

As to claim 2, Zanchi teaches wherein the acquiring comprises searching a database for the set of settings (i.e., from a direct search, fig. 11, fig. 14, fig. 15, col. 8, ll. 10-20).

As to claim 7, Zanchi teaches wherein determining the set of settings comprises determining an environment of the computer device (fig. 12, #1240).

As to claims 8 and 9, Zanchi teaches determining the set of settings for a user (col. 9, ll. 47-49) or a group of users (col. 9, ll. 52-54).

As to claim 10, Zanchi teaches determining an application setting for the operation on the computer device, the application setting being personalized info (preferences, fig. 11-12).

As to claim 15, Zanchi teaches a preference module (program code) that determines a preference between multiple sets of settings when there is a conflict between the multiple sets of settings (col. 3, l. 59 – col. 4, l. 5).

Claims 25 and 35 are drawn to a system or computer readable medium claiming the same invention as system claim 15. Therefore, claims 25 and 35 are rejected based upon the same reasoning as stated above in the rejection of claim 15.

Claims 11-12, 17-22, 26-32, and 37-40 are drawn to a system or computer readable medium claiming the same invention as method claims 1-2, and 7-10. Therefore, claims 11-12, 17-22, 26-32, and 37-40 are rejected based upon the same reasoning as stated above in the rejection of claims 1-2, and 7-10.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3-6, 13-14, 16, 23-24, 33-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zanchi et al (U.S. Patent 5,633,484).

As to claim 3, Zanchi teaches creating the set of settings in a database (the set of settings of fig. 11 have to be created), comprising selecting an existing set of settings (col. 12, ll. 14-16, col. 8, ll. 24-27), and modifying the set of settings (refining the settings from established settings involves modifying the existing settings, col. 8, ll. 24-27). Zanchi further teaches storing data in the existing set of settings in the preference memory database (fig. 11, col. 12, ll. 15-16).

Zanchi does not expressly teach copying the data.

However, official notice is taken that at the time the invention was made, copying data to a database was conventional.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zanchi with the above teachings, such that as the settings are stored in the reference preference memory (fig. 11), the data is copied to the appropriate cell (fig. 11) in the database. The motivation would have been to adapt to the particular requirements of the user or designer. For example, copying the data retains the data from the source as well as copies data to the destination, which will increase data availability.

As to claim 4, Zanchi teaches determining a second set of settings. This is performed when a set of most recent preference entries in a reference preference set (fig. 11, col. 3, l. 59 – col. 4, l. 4) are found. Zanchi further teaches acquiring a first set of settings to perform an operation on a computer, as described above.

Zanchi does not expressly teach that the second set is from a setting in the (first) set of settings, or acquiring a second set of settings.

However, Zanchi teaches a first set of settings (fig. 11, col. 7, l. 60 – col. 8, l. 15). Zanchi further teaches a second set of settings (i.e., a more recent set), as described above. Therefore, the more recent set of settings can correspond to the more recently updated settings for a particular cell, as each cell contains particular user settings (fig. 11) in a preference memory (col. 3, l. 59 – col. 4, l. 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zanchi with the above teachings, such that a

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second set of settings, in the first set of settings, i.e., the more recently updated settings within a cell, are determined and acquired for performing an operation on a computer device. The motivation would have been to facilitate reconciling of multiple conflicting preference sets, as taught by Zanchi (col. 3, l. 59 – col. 4, l. 4), and presenting the user with his/her preferences, taught throughout Zanchi.

As to claim 5, Zanchi, as modified above, further teaches determining a preference between multiple sets (old set vs. new set) of settings (using a time stamp) when there is a conflict between multiple sets of settings (col. 3, l. 66 – col. 4, l. 4).

As to claim 6, Zanchi, as modified above, teaches using a concept of priority (i.e. the most recent time stamp, col. 4, ll. 1-4) to determine a preference between multiple conflicting sets of settings.

Zanchi does not expressly teach ordering the sets by priority.

However, Zanchi suggests that there are at least two time stamps (e.g., old and new), for obtaining “most recent entries” (col. 4, l. 1).

Furthermore, official notice is taken that at the time the invention was made, it was conventional to order (sort) values.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zanchi with the above teachings, such that time stamps are ordered by time priority. The motivation would have been to facilitate finding the most recent time stamp (Zanchi, col. 4, l. 1) when there is a list of times.

Claims 13-14, 16, 23-24, 33-34, and 36 are drawn to a system or computer readable medium claiming the same invention as method claims 3, 4, and 6. Therefore,

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claims 13-14, 16, 23-24, 33-34, and 36 are rejected based upon the same reasoning as stated above in the rejection of claims 3, 4, and 6.

Conclusion

17. The following prior art cited on the PTO-892 form, not relied upon, is considered pertinent to applicant's disclosure:

MacIntosh et al, U.S. Patent 6,973,481 discloses a system and method for creating and managing forwarding email address.

Kennedy et al, U.S. Patent 6,651,217 discloses a system and method for populating forms with previously used data values.

Lenz et al. Pub. No. 2001/0053947 discloses an identification card personalization device with web browser.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Lu whose telephone number is (571) 272-8594. The examiner can normally be reached on 8:30 - 5:00; M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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